

REMARKS

The claims have been amended to more clearly define the invention as disclosed in the written description. In particular, claims 3-5 and 9 have been cancelled, while claims 1 and 10 have been amended to include the limitations of cancelled claims 3 and 4. In addition, the claims have been amended for clarity.

The Examiner has rejected claims 1-6, 10 and 11 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0033960A1 to Kazami. The Examiner has further rejected claims 7-9 and 12 under 35 U.S.C. 103(a) as being unpatentable over Kazami in view of U.S. Patent 6,628,963 to Chung.

The Kazami publication discloses an image recording apparatus and method in which image files are recorded on a recording medium, and in which monitoring means monitors the files on the recording medium and causes certain of the recorded files to be deleted by deleting means in accordance with certain criteria.

As noted in MPEP § 2131, it is well-founded that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Further, "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The subject invention, as claimed in claims 1 and 10, includes the limitations "generating a first list of new content items to be stored, said first list being compiled by a user" and "uploading said first list to a server for selecting the new contents items to be downloaded to the user device".

The Examiner has indicated that the "generating a first list of new content items to be stored, said first list being compiled by a user" limitation is disclosed in Kazami on page 1, paragraph [0017, lines 1-5.

Applicants submit that the Examiner is mistaken. In particular, this section of Kazami states:

"Apparatus according to a first embodiment of the invention includes recording means for acquiring an image file from an imaging component (e.g., a CCD) or an external terminal (e.g., a host computer), and for recording the image file together with time information on a recording medium."

It should be apparent that there is no disclosure or suggestion of a first list being compiled by a user.

The Examiner has further indicated that the "uploading said first list to a server for selecting the new contents items to be downloaded to the user device" limitation is disclosed by "Image Files in figure 1".

Applicants again submit that the Examiner is mistaken. In particular, Fig. 1 merely shows "IMAGE FILE" being applied to "RECORDING MEANS" 1 and the output of "RECORDING MEANS" 1 being applied to "RECORDING MEDIUM" R. There is no disclosure or suggestion of uploading the first list to a server. While the

above-noted section of Kazami indicates that the image file may applied to an external terminal of the image recording apparatus and may originate from a host computer, which may be a server, there is no disclosure or suggestion of the user compiling a first list of content items to be stored, and uploading this first list to a server for selecting the content items to be downloaded to recording apparatus, as clearly and specifically recited in claims 1 and 10.

The Chung patent discloses a portable multimedia player which includes a CD-ROM drive, memory 26 for storing MP3 files "downloaded by way of online communications" (col. 2, lines 55-59), and an MPEG audio section 62 for processing an audio signal, arguably from either memory 26 or from the CD-Rom drive.

However, Applicants submit that Chung does not supply that which is missing from Kazami, i.e., the user compiling a first list of content items to be stored, and uploading this first list to a server for selecting the content items to be downloaded to recording apparatus.

In view of the above, Applicants believe that the subject invention, as claimed, is neither anticipated nor rendered obvious by the prior art, either individually or collectively, and as such, is patentable thereover.

Applicants believe that this application, containing claims 1, 2, 6-8 and 10-12, is now in condition for allowance and such action is respectfully requested.

Respectfully submitted,

by /Edward W. Goodman/
Edward W. Goodman, Reg. 28,613
Attorney
Tel.: 914-333-9611